

REMARKS

Claims 1-34 have been canceled. Claims 35-56 are pending.

INTERVIEW WITH EXAMINER

On April 5, 2005, the attorney for Applicants, Mr. John Wagner, conducted an interview with Examiner Robert Harrell. During the interview, Mr. John Wagner and Examiner Harrell discussed the specification, the rejections, the cited references, and portions of claim language that are common to all of the applications, including the present application, which are continuations of U.S. patent 5,956,487. Examiner Harrell is thanked for the interview.

Terminal Disclaimers

Paragraph 2 of the Office Action states, "In view of the Terminal Disclaimers, all United States Applications should be mentioned in the related section of the specification including their status (i.e., those mentioned in the Double Patenting rejection outlined in examiner's prior action and herein)." The Response filed on August 23, 2004 includes an amendment to the specification on page 3 for related applications and their status. Applicants believe that this rejection has been addressed.

35 U.S.C. § 112 Objection

Specification

In paragraph 5 of the Office Action, the specification was objected to under 35 U.S.C. § 112, first paragraph, as failing to adequately teach how to make and/or use the invention. Applicants have reviewed the specification and respectfully traverse the 35 U.S.C. § 112 objection to the specification.

As discussed with Examiner Harrell during the telephone conference of April 5, 2005, Applicants respectfully submit that the specification as filed complies with the requirements of 35 U.S.C. § 112, first paragraph. Specifically, Applicants respectfully contend that the present specification fully and adequately teaches one of ordinary skill in the art how to make and practice the present claimed invention without undue experimentation. The Office Action mailed April 23, 2004, contends that there was no showing of source code or hardware allowing one to control a device remotely. Applicants respectfully contend that showing source code or hardware allowing one to control a device remotely is not required to comply with 35 U.S.C. § 112, first paragraph. Applicants respectfully point out that the specification must "enable

any person skilled in the art" to make and use invention. Applicants respectfully contend that "one of ordinary skill in the art" would certainly be able to practice the present claimed invention without undue experimentation based on the present specification and without an explicit recitation of source code or hardware allowing for controlling a device remotely. That is, Applicants respectfully submit that the ability to control a device remotely is well within the ability of one of ordinary skill in the art.

Moreover, as an example of the knowledge and ability of one of ordinary skill in the art (no later than the time of filing of the present application), Applicants are providing herewith two issued US patents, 4,689,022 and 5,390,385. Applicants respectfully contend that either of these two patents clearly show that the remote controlling of device was within the scope of the knowledge and ability of one ordinary skill in the art at least as early as the filing date of the present application. Hence, Applicants respectfully submit that the present application as filed complies with the requirements of 35 U.S.C. § 112, first paragraph, and that a request for source code or hardware for remotely controlling a device is not warranted. As such, Applicants respectfully request withdrawal of the 35 U.S.C. § 112, first paragraph objection to the specification.

Additionally, the Office Action dated April 23, 2004 contained a statement reciting, "There is a lack of disclosure and/or written description allowing the devices to interface with the network so they can be monitored and controlled by a remote user via an network." In response to that statement in the Office Action, Applicants replied in a response dated August 23, 2004 by pointing out, "Applicant respectfully submits that claims 35-56 are not directed to allowing devices to interface with a network so they can be monitored and controlled via the network as implied by the Examiner." For further clarification, Applicants included the statement in the response dated August 23, 2004 to merely point out that the statement in the Office Action dated April 23, 2004 did not appear to quote the claims of the present application verbatim. Applicants did not wish to imply any lack of functionality or structure for the present claimed invention.

Similarly the Office Action dated April 23, 2004 contained a statement which recited, "Where is the source code and hardware allowing one to control the video player and/or washing machine by a user on a browser via the network?." In response to that statement in the Office Action, Applicants

replied in a response dated August 23, 2004 by pointing out, "Applicant respectfully submits that claims 35-56 do not recite source code or hardware for allowing control of a device via a network." For further clarification, Applicants included the statement in the response dated August 23, 2004 to merely point out that the statement in the Office Action dated April 23, 2004 did not appear to quote the claims of the present application verbatim. Applicants did not wish to imply any lack of functionality or structure for the present claimed invention.

35 U.S.C. § 112 Rejection

Claims 35-56

In paragraph 7 of the Office Action mailed March 4, 2005, Claims 35-56 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification. Applicants have reviewed the claims and respectfully traverse the 35 U.S.C. § 112, first paragraph rejection of the claims.

As discussed with Examiner Harrell during the telephone conference of April 5, 2005, Applicants respectfully submit that the specification as filed complies with the requirements of 35 U.S.C. § 112, first paragraph. Specifically, Applicants respectfully contend that the present specification fully and adequately teaches one of ordinary skill in the art how to make and practice the present claimed invention without undue experimentation. The Office Action mailed April 23, 2004, contends that there was no showing of source code or hardware allowing one to control a device remotely. Applicants respectfully contend that showing source code or hardware allowing one to control a device remotely is not required to comply with 35 U.S.C. § 112, first paragraph. Applicants respectfully point out that the specification must "enable any person skilled in the art" to make and use invention. Applicants respectfully contend that "one of ordinary skill in the art" would certainly be able to practice the present claimed invention without undue experimentation based on the present specification and without an explicit recitation of source code or hardware allowing for controlling a device remotely. That is, Applicants respectfully submit that the ability to control a device remotely is well within the ability of one of ordinary skill in the art.

Moreover, as an example of the knowledge and ability of one of ordinary skill in the art (no later than the time of filing of the present application), Applicants are providing herewith two issued US patents, 4,689,022 and 5,390,385. Applicants respectfully contend that either of these

two patents clearly show that the remote controlling of device was within the scope of the knowledge and ability of one ordinary skill in the art at least as early as the filing date of the present application. Hence, Applicants respectfully submit that the present application as filed complies with the requirements of 35 U.S.C. § 112, first paragraph, and that a request for source code or hardware for remotely controlling a device is not warranted. As such, Applicants respectfully request withdrawal of the 35 U.S.C. § 112, first paragraph rejection of Claims 35-56.

35 U.S.C. § 102(e) Rejection

Claims 35-56

In paragraph 11 of the Office Action, Claims 35-56 were rejected under 35 U.S.C. § 102(e) as being anticipated by Martenson, (US Patent No. 6,219,708 B1).

Accompanying this Response are Declarations under 37 C.F.R. 1.131 made by each of the co-inventors, Jeffrey A. Morgan and Chandrasekar Venkatraman, to swear behind the Martenson patent. It is respectfully submitted that the Declarations by the Inventors shows that the invention disclosed and claimed in the above-identified patent application was both conceived and reduced to practice in the United States of America prior to the effective date of the Martenson patent. It is submitted that the Declarations show that the present invention disclosed and claimed in the above-identified patent application was made in the United States of America at least no later than April 1996. It is therefore respectfully submitted that the Martenson patent be removed from further consideration as prior art reference under either 35 U.S.C. 102 or 103.

Thus, Applicants respectfully submit that, in light of the above-described Declarations, the 35 U.S.C. § 102(e) rejection of Claims 35-56 over Martenson (US Patent No. 6,219,708 B1) is moot at this time. As such, Applicants respectfully request allowance of Claims 35-56.

103(a) Rejections

Claims 35-56

In paragraph 16 of the Office Action mailed December 9, 2004, Claims 35-56 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Martenson in view of Joao (US Patent No. 5,917,405).

As mentioned above, accompanying this Response is a Declaration under 37 C.F.R. 1.131 made by each of the co-inventors, Jeffrey A. Morgan and Chandrasekar Venkatraman, to swear behind the Martenson patent. It is respectfully submitted that the Declarations by the Inventors show that the invention disclosed and claimed in the above-identified patent application was both conceived and reduced to practice in the United States of America prior to the effective date of the Martenson patent. It is submitted that the Declarations show that the present invention disclosed and claimed in the above-identified patent application was made in the United States of America at least no later than April 1996. It is therefore respectfully submitted that the Martenson patent be removed from further consideration as prior art reference under either 35 U.S.C. 102 or 103.

Thus, Applicants respectfully submit that, in light of the above-described Declarations, the 35 U.S.C. § 103(a) rejection of Claims 35-56 over Martenson in view of Joao is moot at this time. As such, Applicants respectfully request allowance of Claims 35-56.

Furthermore, it is submitted that the Joao reference also does not qualify as a prior art reference under either 35 U.S.C. § 102 or 35 U.S.C. § 103 in view of the Declarations by the co-inventors, Jeffrey A. Morgan and Chandrasekar Venkatraman. More specifically, Joao is a U.S. patent issued from a patent application filed on June, 29, 1999. Thus, the earliest effective date of Joao is June 29, 1999. As shown in the Declarations by the co-inventors, the present invention was made in the United States of America no later than April 1996. Therefore, it is respectfully submitted that Joao reference has been disposed of. Hence, Applicants again respectfully request allowance of Claims 35-56.

Additional Remarks

Applicant has provided herewith an Information Disclosure Statement including a US patent reference, 6,618,754 B1, which Applicants have just been made aware of. Applicants request consideration of the 6,618,754 B1 reference

in accordance with 37 CFR § 1.97 (b)(4). Although submitted for consideration, Applicants respectfully point out that the present claimed invention is not shown or rendered obvious by the 6,618,754 B1 reference. Specifically, the independent Claims of the present application explicitly recite, for example, at Claim 33:

A method of providing a web page to a user of a device wherein the device is a video player that reads video and audio information from an optical storage medium, comprising:

embedding a web server within the video player such that the web server generates the web page for a user interface to the user;

connecting the web server to a computer network; and
obtaining the web page by communicating to the
web server with a web browser. (Emphasis added)

That is, in the present claimed invention, a web server embedded in a device generates a web page for the device (see e.g. page 9, lines 9-12 of the present specification). Also, in the present claimed invention, the web page for the device is not only generated by the web server at the device, but is also stored at the device (see e.g. page 11, lines 10-13 of the present specification). In so doing, in the present invention, a remotely located web browser can then access user interface functions for the device by accessing the web page generated at the device and stored at the device. Applicants respectfully submit that such claimed teachings are not shown or suggested by the 6,818,754 B1 reference.

Unlike the present claimed invention, the 6,818,754 B1 reference discloses using a remote control to "recursively retrieve" embedded compound documents from a device. Once all of the embedded compound documents have been recursively retrieved, the remote control device generates an output document to be outputted to a multimodal output device (see e.g. column 11 lines 10-15). Hence, Applicants respectfully point out that the 6,818,754 B1 reference teaches performing recursive retrieving and then assembling embedded compound documents at a remote controller.

Applicants further respectfully point out that the 6,818,754 B1 reference does not show or suggest:

embedding a web server within the video player such that the web server generates the web page for a user interface to the user;

...

obtaining the web page by communicating to the web server with a web browser.

as is recited in the present Claims. Thus, Applicants respectfully submit that the present claimed invention, is neither shown nor suggested by the 6,818,754 B1 reference.

As a further point of differentiation, the 6,818,754 B1 reference further discloses an approach in which a web browser performs various compound document file retrieval, processing, and output operations (see e.g. column 11 lines 49-54). That is, in such an approach, the web browser performs the same operations the remote control performs in the above discussion. Again, Applicants respectfully point out that the 6,818,754 B1 reference does not show or suggest:

embedding a web server within the video player such that the web server generates the web page for a user interface to the user;

...

obtaining the web page by communicating to the web server with a web browser.

as is recited in the present Claims. Instead, the 6,818,754 B1 reference discloses using a web browser to recursively retrieve compound documents, assemble the compound documents, perform processing operations and then perform outputting operations. Applicants respectfully point out that the 6,818,754 B1 reference does not teach or suggest, or even remotely mention having a web server in a device generate a web page for the device, wherein the web page can be accessed remotely by a web browser. Hence, Applicants respectfully point out that the present claimed invention is not shown or rendered obvious by the 6,618,754 B1 reference.

Applicants have recently been made aware of U.S. patent reference, 6,209,048 by Wolff (referred to hereinafter as "Wolff"). Although Wolff has not been made of record in any previous Office Actions, for the purpose of expediting the prosecution of the present application, Applicants are providing

a Declaration under 37 C.F.R. 1.131 made by one of the co-inventors, Jeffrey A. Morgan, swearing behind Wolff. It is respectfully submitted that the Declaration by the Inventor shows that the invention disclosed and claimed in the above-identified patent application was both conceived and reduced to practice in the United States of America prior to the effective date of the Wolff patent. It is submitted that the Declaration shows that the present invention disclosed and claimed in the above-identified patent application was made in the United States of America prior to February 9, 1996. It is therefore respectfully submitted that the Wolff patent be removed from potential consideration as prior art reference under either 35 U.S.C. 102 or 103.

Conclusion

In light of the above remarks, Applicants respectfully request reconsideration of the rejected claims.

Based on the arguments presented above, Applicants respectfully assert that Claims 35-56 overcome the rejections of record and, therefore, Applicants respectfully solicit allowance of these claims.


Applicants have reviewed the references that the Office Action cited but did not rely upon and respectfully submit that these references neither teach nor suggest the claimed invention.

The Examiner is invited to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Date: _____

5/4/05

Respectfully submitted,
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